

REMARKS**Summary of the Office Action**

In the Office Action, claims 3, 5-7, 9, 21, and 22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Claims 1, 4-8, 10-14, and 19 are rejected under 35 U.S.C. §102 (b) as being anticipated by Japanese Publication No. 60-262735 (hereinafter “JP- ‘735”).

Claims 1, 2, 4-7, 10-14, and 19 are rejected under 35 U.S.C. §102 (b) as being anticipated by U.S. Patent Publication No. 2002/0074718 to *Schlageter*.

Claims 9 and 21-22 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112, second paragraph, set forth in this Office Action and to include all the limitations of the base claim and any intervening claims.

Summary of the Response to the Office Action

Applicants amend claims 1, 5, 9, 19, 21, and 22, and cancel claims 2 without prejudice or disclaimer. Applicants respectfully withdraw claim 3 from consideration. Accordingly, claims 1, 3-14, 19, and 21-22 are pending for further consideration.

All Subject Matter Complies with 35 U.S.C. § 112, second paragraph

Claims 3, 5-7, 9, 21, and 22 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Claims 5, 9, 21, and 22 have been amended to address the alleged ambiguities pointed out by the Examiner in the December 6, 2006 Office Action. Accordingly, Applicant respectfully submits that the rejections of claims 5-7, 9, 21, and 22 are respectfully

traversed in light of the current amendments to claims 5, 9, 21, and 22. With regard to claim 3, Applicants respectfully withdraw claim 3 from consideration.

Accordingly, it is respectfully requested that all rejections under 35 U.S.C. § 112, second paragraph, be withdrawn.

The Rejection Under 35 U.S.C. § 102(b)

Claims 1, 4-8, 10-14, and 19 are rejected under 35 U.S.C. §102 (b) as being anticipated by Japanese Publication No. 60-262735 (hereinafter “*JP- '735*”). Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that *JP- '735* anticipates each and every feature of Applicants’ claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that newly amended independent claims 1 and 19 recite the feature of “the side position regulating mechanism includes a side guide disposed on a side of the sheet transportation path and correspondingly with the side edge position of the sheet and a skew member which skew-transports the sheet toward the side guide.” At least these features are not disclosed or taught by *JP- '735*.

JP- '735 discloses a turntable that rotates and a base plate that translates sheet paper for an imaging apparatus. See Fig. 1 of *JP- '735*. However, *JP- '735* fails to teach or suggest at least the above features of claims 1 and 19.

JP- '735 does not disclose a “side position regulating mechanism [3 that] includes a side guide disposed on a side of the sheet transportation path and correspondingly with the side edge position of the sheet and a skew member which skew-transports the sheet toward the side guide.” If you consider that item 12 of Fig. 1 is a side guide, then there is no structure in *JP- '735* that

acts as a skew member to skew-transport a sheet toward the side guide. Therefore, because *JP-735* does not disclose all the features of newly amended independent claims 1 and 19, it cannot anticipate the present invention.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because *JP-735* does not teach or suggest each feature of newly amended independent claims 1 and 19.

Accordingly, Applicants respectfully submit that dependent claims 4-8 and 10-14 are also allowable insofar as they recite the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

Claims 1, 2, 4-7, 10-14, and 19 are rejected under 35 U.S.C. §102 (b) as being anticipated by U.S. Patent Publication No. 2002/0074718 to *Schlageter*. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that *JP-735* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Namely, Applicants contend that newly amended independent claims 1 and 19 recite the features of cancelled claim 2 which recites "the side position regulating mechanism includes a side guide disposed on a side of the sheet transportation path and correspondingly with the side edge position of the sheet and a skew member which skew-transports the sheet toward the side guide." At least these features are not disclosed or taught by *Schlageter*.

Schlageter discloses a system to decrease the lateral offset of sheets before they reach an active registration system. See Fig. 1 of *Schlageter*. However, *Schlageter* fails to teach or suggest at least the above features of claims 1 and 19.

The Office Action states that "Figs. 1-5 [of *Schlageter*] show that the side position regulating mechanism (including 14, 16, 26, 28, and 74) includes a side guide (16) disposed on a side of the sheet transportation path (near F)." However, *Schlageter* actually discloses drive rollers 14 and 16, nip rollers 26 and 28, and a pivoting transport 74. Contrary to the Office Action, "the roll pairs 14, 26 and 16, 28 engage the sheet S and drive it through the registration unit 10." See page 2 ¶ [0021] of *Schlageter*. That is, *Schlageter* does not disclose that the drive roller 16 is a side guide that receives sheets skewed toward it. Rather the drive roller 16 engages the sheets and drives them through the registration unit. The assertion in the Office Action is erroneous because the drive roller 16 does not act as a side guide at all. See page 2 ¶ [0021-22] of *Schlageter*. Therefore, because *Schlageter* does not disclose all the features of newly amended independent claims 1 and 19, it cannot anticipate the present invention.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(b) should be withdrawn because JP- '735 does not teach or suggest each feature of newly amended independent claims 1 and 19.

Accordingly, Applicants respectfully submit that dependent claims 4-7 and 10-14 are also allowable insofar as they recite the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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